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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,458	07/03/2003	Teruyoshi Komuro	09812.0418-01000	6545
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
			EXAMINER NALVEN, ANDREW L	
			ART UNIT 2134	PAPER NUMBER
			MAIL DATE 08/02/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/613,458

Applicant(s)

KOMURO ET AL.

Examiner

Andrew L. Nalven

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29-32,34-40 and 42-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-32,34-40 and 42-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/3/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/311,608.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 29-32, 34-40, and 42-44 are pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 29-32, 34-40, and 42-44 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 29-32, 34-40, and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warren et al US Patent No. 5,963,909 in view of Hoogendoorn et al US Patent No. 5,083,224.
4. With regards to claims 29 and 37, Warren teaches inputting the data to be recorded onto a recording medium loaded on the recording apparatus (Warren, column 8 lines 19-23, master data is received), converting the input data into a predetermined

Art Unit: 2134

format which is reproducible at the recording apparatus (Warren, column 8 lines 19-26, master data is compressed), generating copy permission information specifying which type of copy permission is associated with the data (Warren, column 8 lines 24-30, SMT data), adding the copy permission information to the converted data (Warren, column 8 lines 24-30, SMT data added to create combined signal) and recording the converted data with the copy permission information onto the recording medium (Warren, column 8 lines 24-30, SMT data 29-30, Figure 3). Warren fails to teach determining whether the input data includes information for controlling copying of the data and adding the copying permission information to the data if the input data does not include any information for controlling copying of the data. However, Hoogendoorn teaches determining whether the input data includes information for controlling copying of the data and adding the copying permission information to the data if the input data does not include any information for controlling copying of the data (Hoogendoorn, column 11 lines 5-14, detects absence of auxiliary signal and adds auxiliary signal if no auxiliary signal is present).

5. With regards to claims 30 and 38, Warren as modified teaches reproducing the data recorded on the recording medium loaded on the recording apparatus (Warren, column 8 lines 35-46).

6. With regards to claims 31 and 39, Warren as modified teaches reading the data recorded on the recording medium (Warren, column 8 lines 35-41), extracting copy permission information from the data recorded on the recording medium (Warren, column 8 lines 40-46, de-multiplexed), generating information for controlling copying of

Art Unit: 2134

the data to be output in accordance with copy permission specified by the copy permission information (Warren, column 9 lines 49-65), and outputting the data along with the generated information for controlling copying of the data (Warren, column 9 line 65 – column 10 line 12).

7. With regards to claims 32 and 40, Warren as modified teaches transforming the data into a form that cannot be reproduced when copied onto the other recording medium (Warren, column 11 lines 16-22).

8. With regards to claims 34, 36, 42, and 44, Warren as modified teaches extracting information for controlling copying of the data included in the input data (Warren, column 10 lines 61-67, column 11 lines 16-21), and comparing a copy restriction level indicated by the information for controlling copying of the data included in the input data with a predetermined copy restriction level (Warren, column 11 lines 16-21), wherein the copy permission information is generated in accordance with the comparison of the copy restriction level and added to the data (Warren, column 11 lines 16-21).

9. With regards to claims 35 and 43, Warren as modified teaches determining whether copy protection of data to be recorded is instructed by a user of the recording apparatus (Warren, column 1 lines 33-50) and wherein the copy permission information is generated and added to the data if copy protection of data to be recorded is instructed (Warren, column 1 lines 33-50).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L. Nalven whose telephone number is 571 272 3839. The examiner can normally be reached on Monday - Thursday 8-6, Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on 571 272 3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andrew Nalven

